

PATENT**REMARKS**

Applicant requests reconsideration of the rejections set forth in the Office action dated 01/04/2005 under the provisions of 37 CFR §1.111(b) and requests entry of the following remarks to the above-identified application as follows:

Applicant notes that this Office Action is designated as a Final Office action. The prior response from the Application was an RCE. Per a telephone conversation between the Examiner and the applicant on 3/09/05, the Examiner and applicant agreed that the indication of finality was in error and that applicant would respond to this office action under rule 1.111(b) so long as the telephone conversation was referenced in the Office Action Reply.

Applicant thanks the Examiner for accepting the drawings filed on 12/10/2004.

Claims 1, 5-8, 12-15, 19-22 and 25-27 are pending.

Claims 1, 5-8, 12-15, 19-22 and 25-27 stand rejected.

Claims 1, 8, 15, 22 and 27 were amended.

I. Initial Comments

Applicant here responds to paragraphs 4 and 6 of the Office Action dated 1/4/05.

With regard to paragraph 4, applicant points out that in claims 1, 8, 15, 22 and 27, the limitation that includes the word "access" is "... a policy to access special paper stock,...". Applicant believes the Examiner may have not understood that this policy allows one of the network devices to use special paper stock for printing (such a company check stock). Applicant has amended claims 1, 8, 15, 22, and 27 to make them more clear by replacing the term "access" with "allow selection of".

With regard to paragraph 6, applicant again asserts that Carroll does not teach anything about electronic payments or billing. In the Office Action dated 08/17/04, at

PATENT

paragraph 15, the Examiner asserted that Figure 3A and 3B teach electronic payment and billing. In the office action reply and RCE sent 12/6/04, applicant has previously petitioned the Examiner to explain in detail how Carroll can be considered to teach anything about electronic payments and billing functions (with respect to Figures 3A and 3B). The Examiner instead has now asserted that Figures 4A and 4B teach electronic billing and payment (see paragraph 6 and the first paragraph numbered as 17 (the first paragraph in the conclusion section is also numbered as 17)). Applicant points out that figures 4A, 4B, 4C and 4d are example web pages for opening a checking account at a bank. The description of these figures start at column 6, line 63 and extend to column 7, line 20. These figures and the associated text teach 1) a client can open a new checking account with a bank securely over the network and 2) specify where to store certificates – such as using KRO (the Key Ring Organizer) or the Browser (fig. 4B and fig. 4D respectively – and referring to 28 the user terminal 18 or 32 in registration authority terminal 16). The opening of a checking account is insufficient to teach electronic billing and payment. If the Examiner is aware of facts that somehow combine with Carroll to teach anything about electronic payments and billing functions, applicant respectfully calls for the Examiner to prepare and provide an affidavit containing specific data and support for this assertion in accordance with 37 CFR 1.104(d)(2).

Furthermore, even if Carroll could be construed to teach electronic billing and payment capabilities, nothing in Carroll teaches or suggests that these capabilities be included with a printer, a copier, a scanner, or a facsimile machine.

II. Rejections under 35 USC §103(a)

Claims 1, 5-8, 12-15, 19-22 and 25-27 stand rejected under 35 USC §103(a) as being unpatentable over Carroll (6,105,131) in view of Debry (6,314,521). This rejection of the claims is respectfully traversed in view of the following arguments.

A prima facie case of obviousness is established by one or more references that were available to the inventor and that teach a suggestion to combine or modify the reference, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of the ordinary skill in the art.

PATENT

The currently amended claims 1, 8, 15, 22 and 27 include the limitation:

wherein the network device is at least one of a printer, a copier, a scanner, and a facsimile machine; and the usage policy is at least one of a policy to allow selection of special paper stock, a policy to allow the network device to decrypt and print a document only if the network user was physically near the network device, a policy to print a selected watermark when printing the document, a policy to enable the network device to accept digital cash associated with an operation on the document, a policy to enable a billing function, a routing policy, and a policy to escrow a document.

These policies are disclosed in the instant application on page 11, line 23 through page 13, line 20.

- a policy to allow selection of special paper stock,
- a policy to allow the network device to decrypt and print a document only if the network user was physically near the network device,
- a policy to print a selected watermark when printing the document,
- a policy to enable the network device to accept digital cash associated with an operation on the document,
- a policy to enable a billing function,
- a routing policy,
- and a policy to escrow a document.

Carroll teaches a secure server system that uses digital certificates. The Examiner has agreed that Carroll does not teach a suggestion to use digital certificates with a printer, a copier, a scanner, or a facsimile machine. Further, Carroll does not teach a suggestion to use the claimed policies with these devices. Applicant strongly asserts that Carroll does not teach electronic billing and payment. Furthermore, even if Carroll could

PATENT

be construed to teach electronic billing and payment capabilities, nothing in Carroll teaches or suggests that these capabilities be included with a printer, a copier, a scanner, or a facsimile machine.

Debry teaches a printer device that uses digital certificates. Debry sets a unique (for each printer) encryption key into the printer at the time of manufacture (C8, lines 17-28). This key is subsequently used to obtain a digital certificate over the network from a certificate authority (C9, lines 15-35). Once the certificate is obtained, the printer is authenticated and can detect tampering of data sent to the printer as well as enforce a number of listed policies (C9, lines 45-58) (although the term "policy" is not included in Debry, a policy is known to those skilled in the art as one or more rules that specifies access rights and/or capabilities. Such a one will also understand that certificates can be used to enforce a policy). Those policies are from Debry Column 9, lines 46-58:

Once a printer is authenticated, such as by the secure configuration of a digital certificate described herein, there are a set of security issues that must be addressed to guarantee that the data has not been tampered with on its way to the printer. Other secure printing considerations include privacy (others cannot look at the print data), user authentication and authorization (the user is who he claims to be and is authorized to perform the operation), nonrepudiation (the user really asked for the operation), and protection from "man-in-the-middle" and "replay" attacks. Some of these issues are addressed in copending patent application Serial No. 08/978,793 which is herein incorporated by reference.

Patent application 08/978,793 issued as patent 6,385,728 ('728) on May 7, 2002. It teaches how digital certificates can be used to control access to the printing system ('723 columns 9 & 10) for example, setting up secure mailboxes, reconfiguring the printer, and deleting jobs.

The Debry patents do not teach or suggest a policy to allow selection of special paper stock, a policy to allow the network device to decrypt and print a document only if the network user was physically near the network device, a policy to print a selected watermark when printing the document, a policy to enable the network device to accept digital cash associated with an operation on the document, a policy to enable a billing function, a routing policy, or a policy to escrow a document.

PATENT

Each of the amended independent claims includes the limitation:

wherein the network device is at least one of a printer, a copier, a scanner, and a facsimile machine; and the policy is at least one of a policy to access special paper stock, a policy to allow the network device to decrypt and print a document only if the network user was physically near the network device, a policy to print a selected watermark when printing the document, a policy to enable the network device to accept digital cash associated with an operation on the document, a policy to enable a billing function, a routing policy, and a policy to escrow a document.

Thus, nothing in Carroll and Debry, separately or combined, teaches or teaches a suggestion that would lead one skilled in the art to implement these policies in a method, a computer program, or a system. Thus, currently amended claims 1, 8, 11, 22 and 27 are patentable.

Claims 5-7 depend on and further limit currently amended claim 1 that is patentable. Thus, claims 5-7 are patentable.

Claims 12-14 depend on and further limit currently amended claim 8 that is patentable. Thus, claims 12-14 are patentable.

Claims 19-21 depend on and further limit currently amended claim 15 that is patentable. Thus, claims 19-21 are patentable.

Claims 25-26 depend on and further limit currently amended claim 22 that is patentable. Thus, claims 25-26 are patentable.

Since all rejections, objections and requirements contained in the outstanding official action have been fully answered or traversed and shown to be inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 CFR §1.111(b) and such reconsideration is respectfully requested. Upon

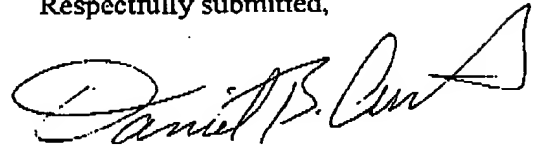
PATENT

reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

The undersigned attorney authorized by Xerox Corporation hereby authorizes the charging of any necessary fees, other than the issue fee, to Xerox Corporation Deposit Account No. 24-0025. This also constitutes a request for any needed extension of time and authorization to charge all fees therefor to Xerox Corporation Deposit Account No. 24-0025.

Should any additional issues remain, or if I can be of any additional assistance, please do not hesitate to contact me at (650) 812-4259.

Respectfully submitted,



DANIEL B. CURTIS
Attorney for Applicants
Reg. No. 39,159
(650) 812-4259
dbcurtis@parc.com